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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/979,567	11/26/1997	KAZUO SHIOTA	2091-0145P-S	5872

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/979,567

Applicant(s)

SHIOTA ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-15, 17-21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-15, 17-21 and 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Status of Claims

1. Claims 1-3, 5-8, 10-15, 17-21 and 23-33 have been examined.

Response to Arguments

2. Initially, the Examiner would like to apologize for any lack of clarity on his part. When the Examiner pointed out that the Applicant's claims, "do not mandate that both sets of data be stored on the same recording medium as suggested by the Applicant (paper 27, page 11, lines 19-21)", it was done only to indicate that the feature in dispute was not included in the claims and not to imply that said feature was not disclosed by Moghadam et al.. On the contrary, in paper no. 30, page 2, lines 5-11, the Examiner clearly states that Moghadam et al. teach storing image data and printing service information on the same recording medium. Hence, the only difference between the prior art combination of Moghadam et al. and Farros et al., and the Applicant's [amended] claimed invention is the portability of the recording medium. And while this is taught by Moghadam et al. (the film is stored on a cartridge) (column/line 7/35-8/26), it has been held that such a modification is considered to be within the level of ordinary skill of the art (*In re Lindberg*, 194, F.2d 732, 735, 93 USPQ 23, 26 (CCPA 1952)), therefore, the Examiner maintains the rejection, as it would have been

obvious to one of ordinary skill to record image data and updateable printing service information on the same portable recording medium.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-8, 10-15, 17-21 and 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of Farros et al., U.S. Patent No. 5,930,810.

As per claims 1-3, 5, 6, 11-13, 18, 19 and 25-27, Moghadam discloses a picture print ordering system comprising the steps of recording picture image data obtained by reading a developed film at a primary and secondary storage unit (figure 4). Moghadam provides for the generation, display and input of printing service related data such as size, quantity, availability and service provider (figures 3 and 5; column 1, lines 55-64; column 4, lines 1-46; column 6,

lines 1-10 and 35-67; column 7, lines 3-26; column 8, lines 1-26). Regarding high resolution images, Moghadam et al. disclose user selection of image resolution (column 6, lines 1-10 and 54-55). Therefore, it would have been obvious to one of ordinary skill in the art to apply the system of Moghadam et al. to high resolution image processing. Although, a user of the Moghadam et al. system utilizes a plurality of print service related data in order to facilitate remote image processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether this data is displayed to the user. Farros et al. teach a printing system that allows a user to view print service information that includes a plurality of attributes (figures 1, 4, 7 and 10, column/line 10/38-11/21) and price data (column 4, lines 37-66). Specifically, Farros et al. teach updateable information for use in generating an updateable order screen displaying available printing services from which a user can select services (figures 5-7; column/line 7/44-8/25). And like Moghadam et al. (figures 3 and 4), Farros et al. teach primary and secondary storage units, as well as using a communications network to produce a user defined "finished product" (figure 4; column 2, lines 60-67; column/line 3/65-4/15; column 7, lines 6-36; column/line 8/9-9/31; column 10, lines 1-36; column 11, lines 22-67). Therefore, it would have been obvious for one of ordinary skill of the art to combine the teachings of Moghadam et al. and Farros et al. Both teach systems that apply modern technological innovations to visual data processing. Specifically, they allow users to communicate processing

specifications (e.g. place an order) directly with service providers over a global network. However, by implementing the system with visual verification and a receipt ('810, column 11, lines 22-67), a user of the Moghadam et al. system can provide evidence of service a request in the event of processing or payment errors.

As per claims 28-33, Moghadam et al. disclose a picture print ordering system that provides for the generation, display and input of printing service related data such as size, quantity, availability and service provider (figures 3 and 5; column 1, lines 55-64; column 4, lines 1-46; column 6, lines 1-10 and 35-67; column 7, lines 3-26; column 8, lines 1-26). Although, a user of the Moghadam et al. system utilizes a plurality of print service related data in order to facilitate remote image processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether the final order is displayed to the user. Recall Farros et al. use receipts and visual confirmation to implement their system, as well as providing an updateable order screen ('810, figures 5-7; column/line 7/44-8/25; column 11, lines 22-67). Receipts and visual confirmation reflect updated information. They also provide evidence of a users service requests and items and/or services purchased. Hence, they necessarily indicate to a user current printing service capabilities of a printing service. Therefore, it would have been obvious to combine the teachings of Moghadam et al. and Farros et al. By implementing the Moghadam et al. system with visual verification and a receipt, a

user can provide evidence of a requested service if he/she is dissatisfied with the finished product and also check for front-end input errors on the part of the user.

As per claims 7, 14, and 20, they are similar to claim 2. Therefore, the rejection of claim 2, is being applied to claims 7, 14 and 20.

As per claims 8, 15 and 21, they are similar to claim 3. Therefore, the rejection of claim 3 is being applied to claims 8, 15 and 21.

As per claims 10, 17 and 23, they are similar to claim 5. Therefore, the rejection of claim 5 is being applied to claims 10, 17 and 23.

As per claim 24, it is similar to claim 18. Therefore, the rejection of claim 18 is being applied to claim 24.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and
after-final communications),

or:

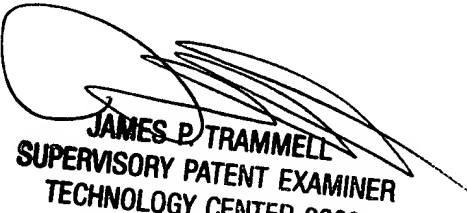
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

February 23, 2003


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600